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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,158	02/27/2004	Philip F. Spalding JR.	026818-000100US	8979
20350 7590 08/06/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER LUBIN, VALERIE				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,158

Applicant(s)

SPALDING, PHILIP F.

Examiner

VALERIE LUBIN

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Individual Patent Application
6) ☒ Other: EAST search history
Paper No(s)/Mail Date _____

DETAILED ACTION

Acknowledgements

1. Claims 1-14 are pending

For reference purposes, the document paper number is 20080729

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-14 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied. This can be done, for example, by identifying the apparatus that accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

Applicant's method steps in claim 1 fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Furthermore, the method steps fail to transform underlying subject matter to a different state or thing.

Claim 2-14, as dependents of claim 1, are rejected under the same analysis.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 is directed to a method comprising the step of "finding life insurance policies whose owners are willing to entertain offers to buy their policies." The limitation is unclear, because Examiner cannot ascertain how existing owners can buy their policies, and if Applicant is referring to buying additional insurance policies. For examining purposes, the claim limitation shall be interpreted as, finding insurance policies whose owners are willing to entertain offers to buy additional policies.

Second, the limitation of "organizing such information..." is unclear, as one of ordinary skill in the art cannot determine what information specifically, "such information" is referring

to. For examining purposes, the limitation shall be interpreted as organizing life insurance information in the database.

Claims 2-14, as dependents of claim 1, are rejected under the same analysis.

6. Claim 8 is also indefinite. The claim recites a database being part of a website, but also a step of providing an appraising service. It is unclear how the two limitations are connected and if Applicant intended for the database to perform the step of providing the appraising service. For examining purposes, the claim shall be interpreted as the method of claim 1 further including providing a service of appraising in-force life insurance policies.

The same analysis applies to claim 10, which for examining purposes, shall be interpreted as the method of claim 1 including receiving e-mail addresses of potential buyers via the website, along with information on parameters of policies desired to be purchased by each potential buyer, and providing to the potential buyers e-mail alerts regarding policies that may be of interest to a potential buyer based on desired parameters supplied by the potential buyer.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4, 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sherman U.S. Patent No. 2001/0034619.

9. With respect to claim 1, Sherman teaches a method comprising the steps of establishing an online database (§ 10, 44); finding insurance policies whose owners are willing to entertain offers to buy additional policies (§ 46); obtaining from such owners underwriting information (§ 24); and requiring pre-arranged membership for a potential buyer to have access to online information (§ 45). With respect to the step of organizing life insurance information in the database, this is an inherent step, as data stored in a database is always organized (§ 45).

Regarding the "whereby..." statement, it has been held that a, "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited" (*Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).

10. Claim 2 is rejected, as Sherman teaches receiving offers online on an Internet website maintaining the database (§ 45).

11. Claim 4 is rejected, as Sherman teaches requiring a pre-arranged membership for a potential policy seller or agent for a potential policy seller (§ 20).

12. Claim 5 is rejected, as Sherman teaches the use of agents to find insurance policies and obtaining information (§ 8, 9).

13. With respect to claim 7, Sherman recites obtained information including personal information (§ 45).

14. Regarding claim 8, Sherman recites a service of appraising in-force life insurance policies (§ 18, 48).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3, 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman U.S. Patent No. 2001/0034619.

17. For claim 3, Examiner takes Official Notice that maintaining auctions on a website for insurance policies was old and well known in the art at the time of the invention. It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Sherman with that of the prior art in order to obtain more competitive prices on insurance policies.

18. For claim 6, Sherman recites advertising to policy holders (§ 46). Sherman also recites obtaining information from policy holders (§ 48). A predictable result of Sherman

would therefore be to invite policy holders to enter such information (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

19. With respect to claim 9, Sherman recites giving authorization to access life insurance information with underwriting information (§ 45, 46, Abstract). A predictable result of Sherman would therefore be for the life insurance and underwriting information to include whatever information relevant to an insured and a policy such as financial and medical data (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

20. For claim 10, Examiner takes Official Notice that providing potential buyers with email alerts regarding policies was old and well known in the art at the time the invention was made, and such step first necessitates receiving potential buyers' email addresses in order to be able to alert them of policies. It would therefore have been obvious to combine the teachings of Sherman with the prior art in order to optimize customer service for clients and keep them informed of transactions or events that impact their policies.

21. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman U.S. Patent No. 2001/0034619 in view of Ariathurai et al., Pre-Grant Pub No. 2002/0198743.

22. For claim 11, Sherman recites a service of appraising in-force life insurance policies (§ 18, 48). Sherman does not specifically recite tracking insurance policies; however, Ariathurai does (§ 15). It would therefore have been obvious to combine the teachings of Sherman to those of Ariathurai to optimize service to policy holders.

23. Claims 12 is rendered obvious over the prior art, as Ariathurai discloses emailing functions between clients and agents and a predictable result of Ariathurai would be to notify clients of any event or transaction that impacts them and/or the insurer (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

Claim 13 is rejected under the analysis of claim 12.

24. Claim 14 is rejected, as Examiner takes Official Notice that enabling a user to request a demonstration of a replacement of the user's policy was old and well known in the art at the time of the invention. It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Sherman and Ariathurai with that of the prior art in order to better inform potential clients of the possible performance and outcome of the replacement policy.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Kendall et al., U.S. Pre-Grant Pub No. 2002/0091613 discloses online auctions on insurance policies, and requesting a demonstration of a replacement policy valuation.
- b) Hanby et al., U.S. Patent No. 7,143,051 discloses notifying clients being alerted via email of insurance proposals.
- c) Deavers, U.S. Patent No. 6,044,352 discloses notifying clients of an upcoming premium due data and amount.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626